

Nos. 17,912, 17,913 and 17,914

IN THE

United States Court of Appeals For the Ninth Circuit

PRAY REFRIGERATION COMPANY, INC.,
a California corporation,
Appellant,

vs.

SEA SPRAY FISHING, INC.,
a California corporation,
Appellee.

No. 17,912

PRAY REFRIGERATION COMPANY, INC.,
a California corporation,
Appellant,

vs.

MAGABOND FISHING INC.,
a California corporation,
Appellee.

No. 17,913

PRAY REFRIGERATION COMPANY, INC.,
a California corporation,
Appellant,

vs.

COURAGEOUS FISHING CORP., INC.,
a California corporation,
Appellee.

No. 17,914

APPELLANT'S REPLY BRIEF

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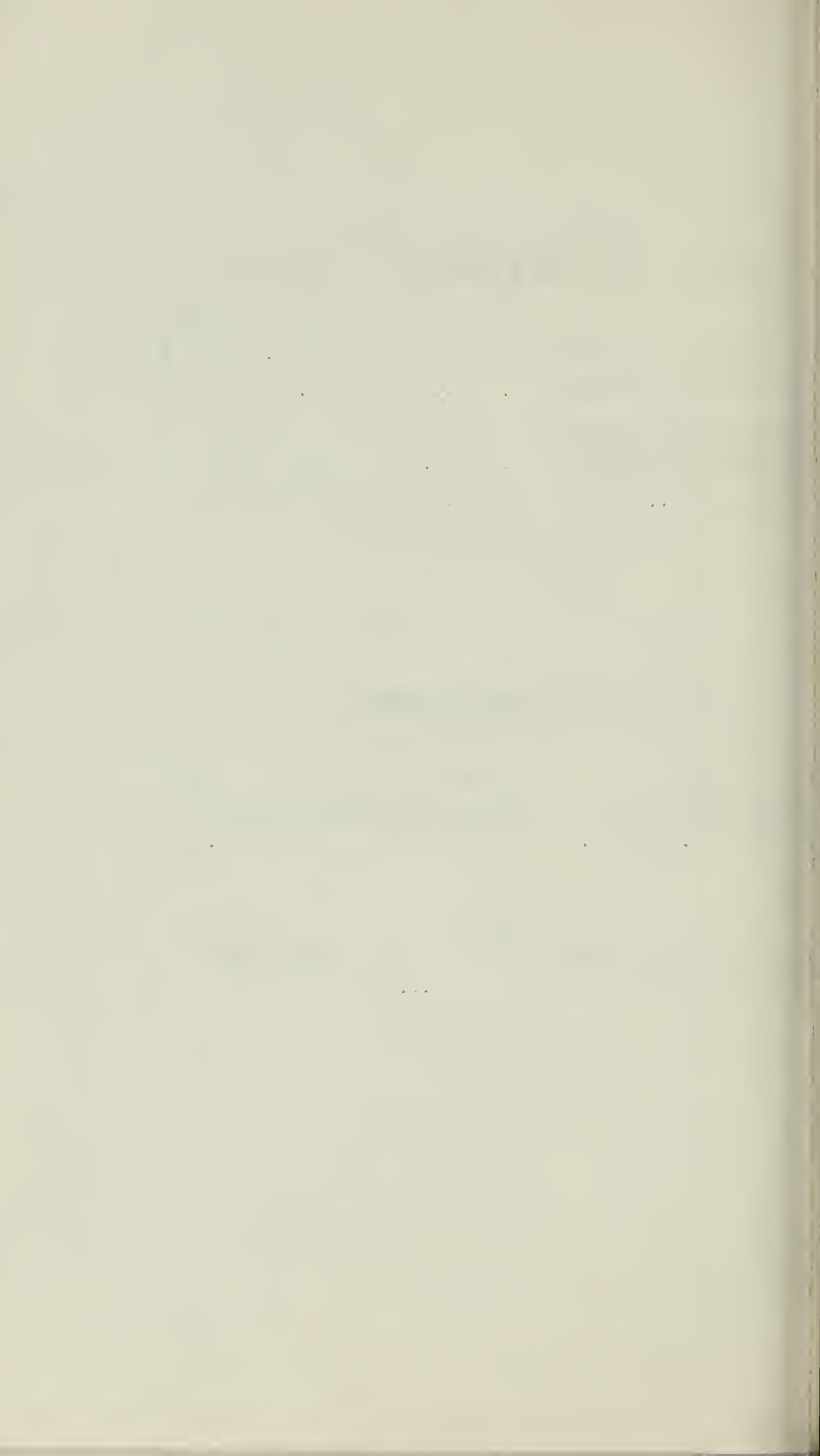
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APPELLANT'S REPLY BRIEF

A reading of the "Brief for Appellant" and the "Brief for Defendants-Appellees" shows the following to be the issues before the Court:

Did the Honorable United States District Judge err in not finding United States Letters Patent 2,909,040 valid and

Did plaintiff sustain its burden of proving infringement?

The Briefs indicate the parties are in agreement on the following matters:

The apparatus on all of the vessels is identical.

The invention of the patent in suit does not reside in the apparatus upon the several vessels but resides in the use of the apparatus.

The apparatus on each of the defendant vessels can be used in an infringing manner and infringement occur when the parties operate the apparatus in such a manner as to build up a reserve layer of ice on the coils.

The same apparatus can be used in a noninfringing manner and infringement does not occur when the apparatus is used in such a manner that a reserve layer of ice is not built up on the coils.

Therefore, the question of infringement can be determined by this Court by a determination of whether or not the evidence shows that ice was built up on the coils.

THE VALIDITY OF THE PATENT IN SUIT.

The validity of the patent in suit was not challenged although invalidity was pleaded as a defense and numerous patents were cited in the Pre-Trial Order. The Examiner in charge of the application had available to

in all of the patents in the Patent Office and the pertinent part relied upon by him is found listed at the end of the patent, Exhibit 1.

As we pointed out in our Opening Brief, the patent is presumptively valid and this presumption is buttressed by the evidence of utility as testified to by the inventor Newell and corroborated by the witnesses Holladay, Lasen and Zierlein.

Under these circumstances the patent should have been, and should be, found to be valid.

INFRINGEMENT BY VAGABOND.

Certainly, plaintiff sustained its burden here because appellee VAGABOND *admits* (pages 17 through 19 of Brief for Defendants-Appellees") that on two occasions it operated its equipment in an infringing manner and so *infringed* Newell's patent. It seeks to excuse its infringement by stating that the use was "experimental" and "de minimis".

Our opening Brief clearly and correctly sets forth the law that the use of the invention by VAGABOND was not experimental in that it was not for the purpose of gratifying philosophical tastes, or curiosity, or for mere amusement. It was a use for profit and was a use in business. Such use is clearly an infringing use.

As the Honorable A. F. St. Sure stated in *Northill Co., et al. v. Danforth*, 51 F. Supp. 928, (modified on other grounds in 142 F. 2d 51):

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As the Honorable A. F. St. Sure stated in *Northill Co., Inc., et al. v. Danforth*, 51 F. Supp. 928, (modified on other grounds in 142 F. 2d 51):

“Defendant testified that he used the anchors for experimental purposes since the reissue date of the Northhill patent, but contends that such use does not constitute an infringement. It has been held that an experimental use for philosophical or amusement purposes is not an infringement, but that where experiments are made commercially, such experimentation may be an infringement. 48 C.J. Sec. 496, p. 296. Defendant’s experiments were evidently not made for philosophical or amusement purposes but were made in connection with his business as a manufacturer and salesman of anchors.”

Moreover a single act of infringement is sufficient to warrant the issuance of an injunction and, this must be particularly so, when it is apparent that the apparatus may be used in an infringing manner at will and at any time the parties may wish to do so; even by accident (Kordich, Tr. V. 3, p. 176). Such is the case at hand. It would work no hardship upon Defendant VAGABOND to be enjoined from operating its apparatus in an infringing manner.

Note Walker on Patents, Deller’s Edition, Volume Three, pages 2132 and 2133:

“But the fact that the defendant has ceased to infringe the patent, and says that he will not infringe it in the future, is no reason for refusing an injunction against him. (Citing cases). * * * If the answer asserts the right to make the alleged infringing devices, a very strong express denial of an intention to do so is necessary to operate as a disclaimer of the intention, and the evidence to sustain the denial must be very clear (Johnson v. Foos Mfg. Co., 141 Fed. 73, C.C.A. 6 (1905)), for whatever tort a man has once

committed, he is likely to commit again, unless restrained from so doing.”

We therefore submit that infringement upon VAGABOND was not experimental and may and should be enjoined.

INFRINGEMENT BY COURAGEOUS.

The testimony of the Witness Aaboen is clear and to the effect that ice was formed upon the coils; hence, COURAGEOUS infringed. The other witnesses are interested parties who operate the vessel on a share basis.

Infringement having been proven, as we have shown in our opening Brief; further infringement should be enjoined. This is particularly so since the apparatus on this vessel, like the apparatus on VAGABOND, can be operated in an infringing manner at any time.

INFRINGEMENT BY SEA SPRAY.

Infringement by SEA SPRAY is clear. The operation of the refrigeration system at the pressures testified to by the witness Franicevich (Tr. V. 3, p. 181) would of necessity result in the formation of ice upon the coils. (See Holladay's testimony in our opening brief, p. 27).

CONCLUSION

It is respectfully submitted therefore that the patent in suit possesses utility, is presumed to be valid, and should have been, and should be, found to be valid.

It is further submitted that the burden of proof of infringement has been sustained.

Infringement upon VAGABOND has been admitted; it was not experimental, and it is sufficient to support the issuance of an injunction.

Infringement upon SEA SPRAY is proven by the witness Aaboen.

Infringement upon COURAGEOUS is proven by the unrefuted testimony of the Engineer Franicevich.

The Judgment of the District Court should be reversed.

Dated, San Francisco, California,

April 2, 1963.

Respectfully submitted,

FLEHR & SWAIN,

Attorneys for Appellant.